

REMARKS

The Examiner's Final Action of August 15, 2003 has been received and its contents carefully considered. Reconsideration is respectfully requested in view of the following comments.

Claims 10-17 are currently pending in the instant application. Claims 1-9 have been cancelled.

I. Rejection under 35 USC 102(a)

Claims 10-12 have been rejected under Section 102(a) as being anticipated by Van. Reconsideration is respectfully requested in view of the following comments.

Van does not disclose a space transformer. According to embodiments of the present invention, a space transformer has one side where the contact pattern has dimensions and spacing in the order of mils (land grid array side), and another side where the contact pattern has dimensions and spacing in the order of microns (IC side). See specification at paragraphs 3, 16, 17 and 21.

For prior art to anticipate under § 102, every element of the claimed invention must be identically disclosed, either expressly or under principles of inherency, in a single reference. Corning Glass Works v. Sumitomo Electric, 9 U.S.P.Q.2d 1962, 1965 (Fed. Cir. 1989). The exclusion of a claimed element, no matter how insubstantial or obvious, from a prior art reference is enough to negate anticipation. Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983) ("Anticipation requires the presence in a single prior art disclosure of all

elements of a claimed invention arranged as in the claim. (Citation omitted) A prior art disclosure that “almost” meets that standard may render the claim invalid under § 103; it does not “anticipate”.) ...if the claim does not literally read, there is no anticipation. Lewmar Marine, Inc. v. Barient Inc., 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987).

Van clearly does not disclose the structure of a space transformer according to embodiments of the present invention. Van does not disclose any *structure* with double sided contacts *that converts a micro pitch scale to a macro pitch scale* as defined in the instant specification. This feature is simply missing from Van, and the Examiner is urged to consider the same. The Examiner points to Beaman et al. to suggest that a substrate with a given structure may be used as a space transformer. Beaman et al. disclose a test probe where a standard packaging substrate is used to provide a space transformer. However, Beaman et al. do not overcome the deficiencies of Van. Beaman et al. do not disclose a space transformer as being made of silicon. In Beaman et al., all references to materials for the substrate for the space transformer are to a metal/ceramic substrate, or a metal/polymer substrate. In addition, the patent referred to in Beaman et al. for the process of fabricating a space transformer, that is, U.S. Pat. No. 5,258,236, refers to the fabrication of a substrate using ceramic, and not silicon.

Accordingly, it is submitted that independent claim 10 is patentable over Van. Moreover, dependent claims 11 and 12 are likewise patentable over Van by virtue of being dependent from independent claim 10, and further for the particular additional features that they recite.

In view of the above, the Examiner is respectfully requested to reconsider and withdraw his rejection of the claims under Section 102(a).

II. Rejection under 35 USC 103(a)

Claims 13-17 have been rejected under Section 103(a) as being unpatentable over Van in view of Petrarca et al. Reconsideration is respectfully requested in view of the following comments.

Petrarca et al. have been cited for their disclosure of an adhesion promoter.

Claims 13-17 all pertain to a space transformer according to embodiments of the present invention. As discussed in Section I above, however, Van does not disclose, or even suggest, a space transformer according to embodiments of the present invention. In addition, Petrarca et al. do nothing to overcome the deficiencies of Van.

Accordingly, it is submitted that claims 13-17 are patentable over the cited combination of references. In view of the same, the Examiner is respectfully requested to reconsider and withdraw his rejection of the claims under Section 103(a).

CONCLUSION


For all the above reasons, the Applicant respectfully submits that this application is in condition for allowance. A Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned at (202) 220-4296 to discuss any matter concerning this application. The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

Dated: 10-14-03

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